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09/437,102	11/09/1999	FREDERICK HERZ		7526

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EXAMINER

MA, JOHNNY

ART UNIT PAPER NUMBER

2623

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/437,102

Applicant(s)

HERZ ET AL.

Examiner

Johnny Ma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 125-141 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 125-141 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 134-141 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments with respect to claims 125-133 have been fully considered but they are not persuasive.

Applicant argues that “Story fails to disclose providing feedback data indicative of video programs selected by a customer during a time interval for viewing during the time interval.”

The examiner respectfully disagrees, as discussed below, the Story reference teaches:

[t]he program processor 175 then solicits the user to define the user preference signal. To this end, the program processor 175 sends prompt signals through the communication network 170 to the user selection interface 150 through the transmission device 160. The prompt signals, which prompt the user to define the user preference signal, are communicated to the user through either a display means located on the user selection interface 150 or the video display 120. The custom user preference signal may comprise, for example, a sequential list of movies, television shows, or other works, that should be transmitted in the entertainment signal...The user selections defining the user preference signal are entered in the user selection interface 150. The user selection interface 150 thereafter provides the user preference signal either as a batch, or contemporaneously as it is being defined, to the transmission device 160. The transmission device 160 transmits the user preference signal to the program processor 175 over the communication network 170” (Story 4:8-52).

The examiner notes that the claimed time interval does not limit the feedback to programs currently selected a viewed at a current time. Rather, the claim only requires that the selection and viewing of a video program occur in the same time interval. Without further language limiting the time interval, the examiner interprets the time interval to be a time allocated by a

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user for viewing television programming. Thus the selection of discrete expressive works for scheduling programming meets the claimed “time interval.” The user of the Story system selects programs or attributes the user wishes to view during the viewing session (time interval) and proceeds to view the selected programming.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., feedback that is not provided before viewing even occurs and passive feedback) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 125, 127-133 are rejected under 35 U.S.C. 102(e) as being anticipated by Story (US 5,541,638 of record).

As to claim 125, note the Story reference that discloses an user programmable entertainment method and apparatus. The claimed “transmitting, to at least one customer set top terminal, video programming data from the at least one video programming source” is met by “[t]he data storage device 180 stores various expressive works, such as television shows, movies

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and news programs in compressed digital data format. Although shown as a singular device, the data storage 180 may comprise a plurality of storage devices which are switchably connected to the communication network 170” (Story 3:55-60) wherein the program processor 175 facilitates transmission of the video programming data (Story 4:65-5:19). The claimed “collecting feedback data from the at least one customer set top terminal, the feedback data indicating at least the video programming selected by the at least one customer through the at least one customer set top terminal during a predetermined time interval for viewing during the predetermined time interval” is met by “[t]he program processor 175 then solicits the user to define the user preference signal. To this end, the program processor 175 sends prompt signals through the communication network 170 to the user selection interface 150 through the transmission device 160. The prompt signals, which prompt the user to define the user preference signal, are communicated to the user through either a display means located on the user selection interface 150 or the video display 120. The custom user preference signal may comprise, for example, a sequential list of movies, television shows, or other works, that should be transmitted in the entertainment signal...The user selections defining the user preference signal are entered in the user selection interface 150. The user selection interface 150 thereafter provides the user preference signal either as a batch, or contemporaneously as it is being defined, to the transmission device 160. The transmission device 160 transmits the user preference signal to the program processor 175 over the communication network 170” (Story 4:8-52) wherein the time interval is the user allocated viewing session, the time interval allocated for viewing programming which commences after selecting the video programs desired. The claimed “selecting a subset of available video programs” is met by “[f]or each UPI in the user preference

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signal, the program processor first selects one or more appropriate DEWs meeting the UPI-defined requirements” (Story 4:65-5:6). The claimed “accessing a plurality of content profiles, each content profile indicative of characteristics of content of a respective one of the plurality of video programs” is met by “[f]or a non-specific UPI...the processor generates a selection list of DEWs that fit the attributes defined in the UPI...[t]o generate the selection list, the processor accesses a database of available DEW titles indexed by attribute” (Story 7:43-60).

The claimed “applying the feedback data to each individual content profile” is met by the creation of the selection list (Story 7:39-60) wherein a comparison of the feedback data (user preference signal) to each individual content profile (DEW data) is inherent to the identification of the DEWs that fit the attributes defined in a UPI. The claimed “controlling a switch connecting the at least one video programming source to respective nodes in a video distribution system so as to selectively transmit the selected subset of video programs to the at least one customer” ” is met by “the data storage device 180 may comprise a plurality of storage devices which are switchably connected to the communication network 170” (Story 3:55-60) wherein “[b]efore the entertainment signal can be transmitted, however, the program processor 175 provides a control signal to the data storage device 180 to establish a point-to-point connection, also called a virtual circuit, with the user node 100. The program processor 175 then locates the storage address of video or audio data for the first selected discrete expressive work within the data storage device 180. The program processor 175 then sends a control signal commanding the data storage device 180 to begin transmitting the data [proposed video programming] at the located storage address to the user station 100 over the communication network 170” (Story 5:1-

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19) and wherein the program processor may also select proposed programming within specified parameters defined by the user (Story 5:20-32).

As to claim 127, the claimed “wherein the step of selecting comprises selecting the subset of available video programs having content profiles that most closely match the at least one customer profile” is met by “the processor generates a selection list of DEWs that fit the attributes defined in the UPI” (Story 7:45-47).

As to claim 128, please see rejection of claim 127.

As to claim 129, please see rejection of claim 127.

As to claim 130, note the Story reference teaches generating a selection list of DEWs that fit the attributes defined in the UPI by accessing a database of available DEW titles indexed by attribute (Story 7:39-60). The claimed “wherein the step of accessing comprises accessing a content profile expressed in mathematical terms” and “wherein the step of applying comprises applying the feedback data to the content profile expressed in mathematical terms” are met by the processor accesses a database of available DEW titles indexed by attribute (Story 7:51-60) and the processor generates a selection list of DEWs that fit the attributes defined in the UPI (Story 7:39-50) wherein the content profile (database) is inherently expressed in mathematical terms since mathematical terms is how a processor acts on data.

As to claim 131, the claimed “wherein the step of controlling comprises scheduling the transmission of the selected subset of available video programs to the at least one customer” is met by the program processor that schedules programming for transmission (Story 5:8-32; 7:61-8:43).

As to claim 132, the claimed “wherein the steps of transmitting, collecting, selecting and controlling are performed by a head-end of a cable television network” is met by “[a] remotely located program processor 175 is also connected to the communication network 170. The program processor 175 is located at a location central to a plurality of user nodes which are similar to the user node 100. The program processor 175 comprises a computing device that operates to execute the functions within the flow chart discussed below in connection with FIGS. 2 and 3” (Story 3:37-45) wherein the communication network comprises cable as taught by the U.S. Patent Number 5,247,347, incorporated by reference (Story 3:30-36).

As to claim 133, the claimed “wherein at least one node is connected to transmit the selected subset of video programs to a plurality of the at least one set-top terminal” is met by “each user of the entertainment services provided by the present invention requests and obtains entertainment services through a user node 100” (Story 3:8-20).

As to claims 134 and 136-141, please see rejections of claims 125 and 127-132.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 126 and 135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Story (US 5,541,638 of record) in further view of Hendricks et al. (US 5,600,364 of record).

As to claim 126, the claimed “updating at least one customer profile of the at least one customer based on the feedback data” is met by “[i]n step 360, the processor determines whether



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the user is interrupting to redefine the UPS [customer profile]...If the answer in step 360 is yes...the program returns to step 230 in FIG. 2” (Story 8:44-54).

The claimed “the at least one customer profile indicating preferences of the at least one customer for particular characteristics of content” is met by the user preference signal that contains information about the desired attributes (preferences) of the system user (Story 4:15-31).

However, the Story reference does not explicitly teach “wherein the step of applying comprises comparing the feedback data to the at least one customer profile.” Now note the Hendricks et al. reference that teaches a network controller for cable television delivery systems wherein subsequent to receiving programming, the operations center 202 packages the programs into the groups and categories which provide the optimal marketing of the programs to subscribers (Hendricks 8:43-46). The claimed “wherein the step of applying comprises comparing the feedback data to the at least one customer profile” is met by Viewer Profile database and Program Scheduling database (Hendricks 29:43-53) used for scheduling programming (Hendricks 8:61-63) compared to feedback information for updating and modifying the program scheduling to provide to optimal marketing of the programs to subscribers (Hendricks 8:29-36; 27:25-34; 30:36-49; 36:11-14; 38:45-53).

As to claim 135, please see rejection of claim 126.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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